UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/498,515	02/04/2000	Howard G. Page	1285	8911

28004   7590   09/06/2012
SPRINT
6391 SPRINT PARKWAY
KSOPHT0101-Z2100
OVERLAND PARK, KS 66251-2100

EXAMINER
RETTA, YEHDEGA

ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
09/06/2012	PAPER

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PTOL-90A (Rev. 04/07)

1   UNITED STATES PATENT AND TRADEMARK OFFICE
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4   BEFORE THE BOARD OF PATENT APPEALS
5   AND INTERFERENCES
6   _____
7
8   *Ex parte* HOWARD G. PAGE,
9   MIKE O'BRIEN,
10   and JAY CEE STRALEY
11   _____
12
13   Appeal 2011-008572
14   Application 09/498,515
15   Technology Center 3600
16   _____
17
18
19   Before LINDA E. HORNER, ANTON W. FETTING, and
20   MEREDITH C. PETRAVICK, *Administrative Patent Judges.*
21   FETTING, *Administrative Patent Judge.*

22   DECISION ON APPEAL
23

1   STATEMENT OF THE CASE[1]

2   Howard G. Page, Mike O'Brien, and Jay Cee Straley (Appellants) seek

3   review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1, 5, 7, 8,

4   10-12, 17, 18, 20, and 21, the only claims pending in the application on

5   appeal.[2] We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)

6   (2002).

7   The Appellants invented a video advertising system that selects and

8   inserts video advertising into the video content of a video-on-demand

9   system. (Specification 2:14-16). The invention selects video advertising for

10   individual target viewers based on their viewer profile and their video

11   content selection (Specification 3:13-15). The video advertising insertion

12   system (1) receives a video stream carrying selected video content from a

13   video-on-demand system, (2) selects and inserts video advertising into the

14   video stream, and (3) transfers the video stream carrying both the selected

15   video content and the selected video advertising for display to a target

16   viewer. (Specification 3:18-23).

17   An understanding of the invention can be derived from a reading of

18   exemplary claim 1, which is reproduced below [bracketed matter and some

19   paragraphing added].

_____

[1] Our decision will make reference to the Appellants' Appeal Brief ("App.
Br.," filed December 13, 2010) and Reply Brief ("Reply Br.," filed April 28,
2011), and the Examiner's Answer ("Ans.," mailed February 28, 2011).
[2] The Board issued a prior decision in the present application in Appeal
2007-1333 on November 6, 2007.

1   1. A method

2   for providing video advertising

3   where a video-on-demand system receives a request from
4   a target viewer for selected video content,

5   and in response,

6   transfers the selected video content in a video
7   stream to the target viewer,

8   the method comprising:

9   [1] selecting video advertising

10   that has a subject matter relation

11   to the selected video content

12   requested by the target viewer;

13   [2] determining an insertion point

14   in the selected video content

15   for the selected video advertising,

16   wherein the insertion point comprises

17   data indicating where

18   in the selected video content

19   the selected video advertising is to be
20   inserted;

21   [3] transferring the selected video content

22   to a target viewer device

23   over a first transport system

24   and

25   transferring the selected video advertising

26   to the target viewer device

27   over a second transport system,

28   wherein the first transport system uses greater

29   bandwidth for video transfer

1   than the second transport system;

2   [4] transferring the insertion point

3   to the target viewer device

4   over the second transport system;

5   [5] storing the selected video advertising

6   in video storage

7   of the target viewer device;

8   [6] transferring the selected video content

9   in the video stream

10   from the target viewer device

11   to a display device;

12   [7] interrupting the transferring

13   of the selected video content

14   in the video stream

15   at the insertion point;

16   [8] retrieving the selected video advertising

17   from the video storage;

18   [9] inserting the selected video advertising

19   into the video stream;

20   [10] resuming the transferring of the selected video content

21   in the video stream

22   at the insertion point;

23   and

24   [11] disabling fast-forward capability

25   when the selected video advertising is displayed.

1   The Examiner relies upon the following prior art:

Farmer	US 5,822,018	Oct. 13, 1998
Eyer	US 6,588,015 B1	Jul. 1, 2003
Zigmond	US 6,698,020 B1	Feb. 24, 2004
Swix	US 6,718,551 B1	Apr. 6, 2004

2   "NDS: NDS' XTV(TM) time shifting technology empowers th[e] viewer
3   and the broadcaster", M2 Presswire, Sep. 10, 1999.

4   Claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 stand rejected under

5   35 U.S.C. § 103(a) as unpatentable over Swix, Farmer, Zigmond, XTV, and

6   Eyer.

7   <center>ISSUES</center>

8   The issues of obviousness turn primarily on whether the Examiner

9   presented articulated reasoning with rational underpinnings to transfer

10   Swix's video content and insertion data over separate transport systems as

11   required by limitations [2]-[4].

12   <center>FACTS PERTINENT TO THE ISSUES</center>

13   The following enumerated Findings of Fact (FF) are believed to be

14   supported by a preponderance of the evidence.

15   *Facts Found in the Prior Decision.*

16   01.   The factual findings in the "FINDING OF FACT" section of

17   the prior Board decision mailed November 6, 2007 are adopted

<center>5</center>

1   and incorporated by reference.[3]

2   *Farmer*

3   01.   Farmer is directed to normalizing signal levels in a signal

4   processing system. (Farmer, col. 1, ll. 8-10.)

5   02.   In many prior art CTV systems, ad-insertion is handled by a

6   combination of cue tone detectors, switching equipment and tape

7   players which hold the advertising material. Upon receipt of the

8   cue tones, a CTV insertion controller automatically turns on a tape

9   player containing the advertisement. Switching equipment then

10   switches the system output from the video and audio signals

11   received from the programming source to the output of the tape

12   player. When switched, these successive program and advertising

13   segments usually feed to a radio-frequency (RF) modulator for

14   delivery to the subscribers.   (Farmer, col. 1, ll. 37-51.)

15   03.   In addition to the video and audio channels, Farmer's receiver

16   21 transmits cue tones on line 23 to ad-insertion system 24 which

17   uses the cue tones to generate timing signals for controlling the

18   insertion of advertising into the program material. When operated,

19   switch 25 routes either the program audio and video, which appear

20   on lines 22, or the advertising video and audio, which appear on

21   lines 27, to modulator 30 via lines 33. Modulator 30 modulates the

22   video and audio onto an RF carrier that it transmits to subscribers

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[3] The prior Board decision made findings of fact pertaining to claim
construction of "transport" and "transport system" and the scope and content
of Swix, Eyer, and XTV.

1   along with all other channels via combiner 28. (Farmer, col. 4, ll.

2   25-48.)

3   *Zigmond*

4   04. Zigmond is directed to displaying advertisements to viewers of

5   video programming by selecting and inserting advertisements into

6   a video programming feed at the household level. (Zigmond, col.

7   1, ll. 8-12)

8   ANALYSIS

9   This is the second time this application has come before the Board. In

10 the prior appeal, the Board panel affirmed the rejection of the claims then

11 pending in the application as being unpatentable over Swix, Eyer, and XTV.

12 As we stated *supra*, the invention inserts ads into a video stream. The

13 primary reference applied, Swix, does this by inserting tones in the video

14 stream that mark where ads are to be inserted. The video stream, containing

15 tone markers, is transmitted separately from the ads, and the two are merged

16 after transmission. Limitation [2] as drafted at the time of the Board's prior

17 decision essentially recited this, and the panel affirmed the Examiner's

18 rejections.

19   Subsequent to the prior appeal, Appellants added limitations that: altered

20 the insertion in limitation [2] to a determination of an insertion point; added

21 the wherein clause to limitation [2]; changed the object of the limitation [3]

22 transfers from a target viewer to a target viewer device; and added

23 limitations [4] through [10]. As a result, the Examiner now applies two

24 additional references, *viz.* Farmer and Zigmond.

7

1   In particular, because limitation [2] now determines an insertion point

2   rather than simply inserting the advertisement, and recites that the insertion

3   point comprises data, and limitation [4] transfers the insertion point data

4   over the transport system not used for the video content, Swix no longer

5   describes the insertion as claimed. Swix embedded the insertion points in

6   the video content precluding their transmission separate from the video

7   content.

8   Farmer describes a satellite system feeding a cable TV system for

9   broadcasting video content. Farmer has facial similarity to the claim, in that

10   it transmits cue tones separate from the video content to the cable operator to

11   show where to insert ads. The similarity falters because Farmer does so

12   prior to transmission from the cable operator to viewer. The claim limitation

13   [3] requires transferring content and ads separately to the target viewer

14   device over the two transport systems.

15   By the time the video in Farmer is transmitted to the viewer, the merge

16   has already occurred, apparently different from limitation [3]. Farmer does

17   this for at least the reason that Farmer is manipulating analog signals,

18   requiring expensive special purpose equipment, contrasted with Swix and

19   the claimed subject matter using digital data signals. Viewers are unlikely to

20   invest in such equipment for the benefit of the advertisers.

21   The Examiner attempts to clear this hurdle by construing the word

22   "over" to not require complete coverage. Ans. 8. That is, so long as any of

23   the signal transports occur separately, each is transferred over those separate

24   transports on their way to the target viewer. While such a construction may

25   be creative, it lands the Examiner on a paradox, for limitation [4] still

1 requires that the insertion point data arrive at the viewer device. Farmer's

2 insertion data disappears with the merge process. The Examiner attempts to

3 clear this hurdle by going back to Swix, suggesting one of ordinary skill

4 would postpone the merge until the data reached the viewer. Ans. 4-5.

5   This essentially is the crux of two of Appellants' arguments. The first

6 argument is that

7   [o]nly a single transport system exists between Farmer CTV

8   System 20 and the target viewer devices. Therefore, it is not

9   possible for Farmer to teach *transferring the insertion point to*

10   *the target viewer device **over the second transport system*** as

11   asserted in the Final Office Action because Farmer does not

12   have a second transport system which links CTV System 20 to

13   the target viewer devices. The Farmer timing signals and video

14   content are combined at Switch 25 and transmitted to the target

15   viewer devices over **a single transport system**.

16 Appeal Br. 6-7. The second argument is that the

17   purported motivation for combining Farmer with Swix is "in

18   order for a local program to control the insertion point of the

19   local advertisements" (pg. 3, lines 7-8). However, this

20   motivation would not lead to use of Farmer. In Farmer, the Ad-

21   Insertion System and the switching and modulating functions

22   which combine the advertising material with the program

23   material are located in the centralized distribution equipment of

24   the cable television system (figs. 1 and 3). The advertisements

25   are inserted into the program material before it is transmitted to

26   the cable distribution system (fig. 1). Therefore, **Farmer does**

27   **not teach or suggest allowing "a local program to control**

28   **the insertion point of the local advertisements"** as stated in

29   the Final Office Action.

30 Appeal Br. 8. Thus, one way or another, Farmer does not describe limitation

31 [4] and the Examiner's attempt to provide Swix as motivation to carry the

32 insertion data to the viewer device fails because, while Swix does indeed

1   show deferring insertion until signal arrival at the viewer device, Swix

2   embeds the insertion data in the video content.

3   The Examiner attempts to clear this hurdle by introducing Zigmond,

4   which does indeed merge an ad into video content at the viewer device based

5   on a trigger signal separate from the video content. But Zigmond obtains the

6   trigger data from the video content at the viewer device to do so. Zigmond

7   does not support the Examiner's theory of keeping the insertion data

8   separate from the video content during transmission. To the extent the

9   Examiner is relying on Farmer's transmission from the satellite to the cable

10   operator for such separate transmission, again, this would not apply in the

11   digital domain of Swix and Farmer. Thus, we agree with Appellants that the

12   Examiner failed to articulate a reason with rational underpinning to transfer

13   Swix's video content and insertion data over separate transport systems.

14   The only remaining independent claim, claim 12, has comparable

15   limitations.

CONCLUSIONS OF LAW

17   The rejection of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 under

18   35 U.S.C. § 103(a) as unpatentable over Swix, Farmer, Zigmond, XTV, and

19   Eyer is improper.

DECISION

21   The rejection of claims 1, 5, 7, 8, 10-12, 17, 18, 20, and 21 is

22   reversed.

<u>REVERSED</u>

24   JRG

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